



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/413,728	10/06/1999	THOMAS J. MARSAN	B-65583(0143	2353

20594 7590 10/18/2002

CHRISTOPHER J. ROURK
AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.
P O BOX 688
DALLAS, TX 75313-0688

EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 10/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/413,728

Applicant(s)

MARSAN ET AL.

Examiner

Igor Borissov

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,11-19 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,11-19 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

THIS ACTION IS NOT MADE FINAL

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4-7, 11-19 and 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Nair et al. (U. S. 5,479,530).

Nair et al. teach to an apparatus and method for capturing a signature applied to a receipt, comprising:

As per **claims 1**,

- a substitute draft system operable to receive a retrieval request and to generate a substitute draft in response to the retrieval request (Fig. 33; column 68, lines 9-28);
- a merchant interface coupled to the substitute draft system, the merchant interface operable to generate a merchant request in response to the retrieval request (column 67, lines 62-63);
- a mediation charge system coupled to the merchant interface, the mediation charge system operable to receive a mediation charge and to generate a merchant mediation charge if no response has been received to the merchant request (column 2, lines 1-15; column 4, lines 18-28; column 5, line 48 through column 6, line 38; column 17, line 10 through column 19, line 24).

As per **claim 2**, the term “inhibit system” encompasses transaction processor (See Fig. 2, item 12).

Art Unit: 3629

As per **claims 4 and 5**,

- a merchant system operable to receive the merchant request and retrieve identification data in response (the host computer 40 of the transaction processor causes a receipt file stored in the storage to be searched) (column 68, lines 14-16).

As per **claims 6 and 7**,

- a bankcard system and bank system operable to generate the retrieval request and receive the substitute draft (bank card association generate a retrieval request and receive reproduced receipt) (column 18, lines 30-31; column 68, lines 9-28, 36-39). The bankcard association comprises banks that issue credit cards (column 17, lines 20-27).

As per **claims 11 and 21**,

- receiving the retrieval request (Fig. 33; column 68, lines 9-28);
- generating the substitute draft if it is determined that a retrieval request code is not in a set of retrieval requests codes that would prohibit the generation of the substitute draft (Fig. 33; column 2, lines 1-15; column 4, lines 18-28; column 5, line 48 through column 6, line 38; column 17, line 10 through column 19, line 24; column 46, lines 46-49; column 50, lines 28-35; column 68, lines 9-28);
- generating a merchant request in response to the retrieval request (column 67, lines 62-63).

As per **claims 12 and 22**,

- receiving the retrieval request (Fig. 33; column 68, lines 9-28);
- generating the substitute draft if it is determined that issuing bank data is not in a set of issuing bank data that would prohibit the generation of the substitute draft (column 2, lines 1-15;

Art Unit: 3629

column 4, lines 18-28; column 5, line 48 through column 6, line 38; column 17, line 10 through column 19, line 24; column 46, lines 46-49; column 50; lines 28-35; column 68, lines 9-28);

- generating a merchant request in response to the retrieval request (column 67, lines 62-63).

As per **claims 13 and 23**,

- receiving the retrieval request (Fig. 33; column 68, lines 9-28);
- generating the substitute draft if it is determined that bank card agency data is not in a set of bank card agency data that would prohibit the generation of the substitute draft (column 2, lines 1-15; column 4, lines 18-28; column 5, line 48 through column 6, line 38; column 17, line 10 through column 19, line 24; column 46, lines 46-49; column 50, lines 28-35; column 68, lines 9-28);
- generating a merchant request in response to the retrieval request (column 67, lines 62-63).

As per **claims 14 and 24**,

- receiving the retrieval request (Fig. 33; column 68, lines 9-28);
- generating the substitute draft if it is determined that transaction amount data is not in a set of transaction amount data that would prohibit the generation of the substitute draft (column 2, lines 1-15; column 4, lines 18-28; column 5, line 48 through column 6, line 38; column 17, line 10 through column 19, line 24; column 46, lines 46-49; column 50, lines 28-35; column 68, lines 9-28);
- generating a merchant request in response to the retrieval request (column 67, lines 62-63).

Art Unit: 3629

As per **claims 15 and 25**,

- receiving the retrieval request (Fig. 33; column 68, lines 9-28);
- generating the substitute draft if it is determined that card user data is not in a set of card user data that would prohibit the generation of the substitute draft (column 2, lines 1-15; column 4, lines 18-28; column 5, line 48 through column 6, line 38; column 17, line 10 through column 19, line 24; column 46, lines 46-49; column 50, lines 28-35; column 68, lines 9-28);
- generating a merchant request in response to the retrieval request (column 67, lines 62-63).

As per **claim 16**,

- a bank system operable to generate the retrieval request in response to user-entered data (bank generate a retrieval request) (column 18, lines 30-31; column 68, lines 9-28);
- a bankcard system comprising banks operable to receive the retrieval request from the banks (column 17, lines 20-27; column 18, lines 30-31; column 68, lines 9-28);
- a transaction system coupled to the bankcard system operable to receive the retrieval request and to generate a substitute draft and a merchant request, the transaction system is operable to assess a mediation charge against the merchant system if the merchant system has not generated sales draft data in response to the merchant request (column 2, lines 1-15; column 4, lines 18-28; column 5, line 48 through column 6, line 38; column 17, line 10 through column 19, line 24; column 46, lines 46-49; column 50, lines 28-35; column 67, lines 62-63; column 68, lines 9-28);
- a merchant system coupled to the merchant interface and operable to receive the merchant request and generate sales draft data in response (column 67, lines 62-63).

Art Unit: 3629

As per **claims 17-19**, the transaction system (processor) is operable to receive bank system data, card user data and transaction amount data with the retrieval request and to generate a substitute draft in response (column 67, lines 62-67; column 68, lines 4-6, 11-14).

REMARKS

Upon reconsideration, the Examiner finds that the limitations cited in the original claims 3 and 20 are, in fact, shown by Nair et al. (U.S. 5,479,530). These features were amended into claims 1 and 16 respectively and have been addressed in the discussions for those claims. Likewise, claims 11-15 have new grounds of rejection, as explained herein.

THIS ACTION IS NOT MADE FINAL. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action.

Conclusion

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks
Washington D.C. 20231***

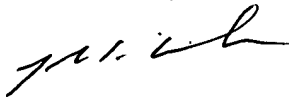
or faxed to:

(703) 305-7687

[Official communications; including
After Final communications labeled
"Box AF"]

Art Unit: 3629

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600